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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 15142US02			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10765813	Filed 01/27/2004			
	First Named Inventor Lakshamanan Ramakrishnan				
	Art Unit 2483	Examiner David N. Werner			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,052</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="width: 50%; vertical-align: top; padding-bottom: 10px; border-left: 1px solid black; padding-left: 10px;"><div style="border-bottom: 1px solid black; margin-bottom: 5px;">/Mirut P. Dalal/</div><div style="text-align: right; margin-bottom: 5px;">Signature</div><div style="border-bottom: 1px solid black; margin-bottom: 5px;">Mirut P. Dalal</div><div style="text-align: right; margin-bottom: 5px;">Typed or printed name</div><div style="border-bottom: 1px solid black; margin-bottom: 5px;">312-775-8000</div><div style="text-align: right; margin-bottom: 5px;">Telephone number</div><div style="border-bottom: 1px solid black; margin-bottom: 5px;">August 12, 2011</div><div style="text-align: right; margin-bottom: 5px;">Date</div></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,052</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<div style="border-bottom: 1px solid black; margin-bottom: 5px;">/Mirut P. Dalal/</div> <div style="text-align: right; margin-bottom: 5px;">Signature</div> <div style="border-bottom: 1px solid black; margin-bottom: 5px;">Mirut P. Dalal</div> <div style="text-align: right; margin-bottom: 5px;">Typed or printed name</div> <div style="border-bottom: 1px solid black; margin-bottom: 5px;">312-775-8000</div> <div style="text-align: right; margin-bottom: 5px;">Telephone number</div> <div style="border-bottom: 1px solid black; margin-bottom: 5px;">August 12, 2011</div> <div style="text-align: right; margin-bottom: 5px;">Date</div>
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<input checked="" type="checkbox"/> *Total of _____ forms are submitted.					

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
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8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 15142US02)

In the Application of:)	
)	
Ramakrishnan)	Electronically filed
)	
Serial No.: 10/765,813)	August 12, 2011
)	
Filed: 1/27/2004)	
)	
Examiner: Werner)	
)	
Group Art Unit: 2621)	
)	
Confirmation No.: 2449)	
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PRE-APPEAL BRIEF

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

This correspondence is filed in response to the Office
Action of May 12, 2011.

REMARKS

Claims 9-12 and 20-21 are presently pending, and claim 23 is added. Claims 1-4 and 13-15 are withdrawn from consideration. Claims 5-8, 16-19, and 22 are cancelled without prejudice. Pre-appeal review is respectfully requested.

Claims 9, 20, and 23 were rejected under 35 U.S.C. 103(a) as being obvious from the combination of Piazza in view of Vartti, and further in view of Lee.

In the Previous Response, Assignee Argued:

Piazza indicates that "The compressed macroblock is then loaded into cache memory 810 (paragraph 0066). Cache memory 810 is the claimed 'local buffer'." Office Action at 3. However, Piazza does not teach that "compressed video data stored in the local buffer, wherein the portion comprises a macroblock row". However, the Office Action indicates that Lee discloses "a macroblock row", and that it would be obvious to combine Piazza, and Vartti, with Lee.

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie*

conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. MPEP 2142.

Office personnel should consider all rebuttal arguments and evidence presented by applicants. See, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 (error not to consider evidence presented in the specification). *C.f.*, *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (error not to consider factual evidence submitted to counter a **35 U.S.C. 112** rejection); *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992) (Office personnel should consider declarations from those skilled in the art praising the claimed invention and opining that the art teaches away from the invention.); *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788 ("[Rebuttal evidence] may relate to any of the *Graham* factors including the so-called secondary considerations."). MPEP 2145.

Assignee respectfully submits that the use of "macroblock rows" provides unexpected results. In the present case, the combination of Piazza and Vartti differ from the present invention in that Piazza and Vartti do not teach "macroblock rows", but only a macroblock.

MPEG-2 uses variable length coding. In variable length coding, later symbols are data-dependent on earlier

symbols. Accordingly, the later symbols cannot be decoded without the earlier symbols. To allow encoding starting at various intervals, MPEG-2 uses what are known as slices. Slices can include several macroblocks. A variable length decoder cannot start with decoding a given macroblock that occurs in the middle of a slice.

However, according to the MPEG-2 standard, the first macroblock of a row is guaranteed to be the first macroblock of a slice. Therefore, by using macroblock rows, the variable length decoder can always start decoding the macroblock row, and consequently, each macroblock in the row. Thus, use of macroblock rows provides an unexpected results over just macroblocks. The unexpected results are evidence of the non-obviousness of adding "macroblock rows" to Piazza and Vartti, notwithstanding the teachings of Lee.

In Response Examiner Relies on Ex Parte Obiaya:

Contrary to Examiner's assertion, the facts of the present case are not even remotely similar to Ex Parte Obiaya. In Obiaya, "Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, *the Board held this advantage would flow naturally from following the suggestion of the prior art*" and a result "flowing naturally from following the suggestion of the prior art cannot be the basis for patentability *when the differences would be otherwise obvious.*" Emphasis Added. Additionally, in Obiaya, the Board found that the combination of references merely produced *additive* benefits.

However, in the present case, Assignee has clearly shown above that the results and unexpected advantages

would not flow naturally from following the suggestion of the prior art.

Examiner argues that "Lee discloses the claimed use of macroblock rows (slices) and that it discloses a benefit of reduction in a processing bottleneck during entropy decoding as a result of the use of macroblock rows." However, the advantage that "the first macroblock of a row is guaranteed to be the first macroblock of a slice. Therefore, by using macroblock rows, the variable length decoder can always start decoding the macroblock row, and consequently, each macroblock in the row" does not flow naturally from the alleged advantage shown in Lee.

Conclusion

For at least the foregoing reasons, each of the pending claims is in a condition for allowance. Examiner is requested to pass this case to issuance.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,



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Attorney for Assignee

August 12, 2011

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